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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/625,955

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David O. Lewis

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IBM CORPORATION, INTELLECTUAL PROPERTY LAW

DEPT 917, BLDG. 006-1

3605 HIGHWAY 52 NORTH

ROCHESTER, MN 55901-7829

EXAMINER

HENEGHAN, MATTHEW E

ART UNIT

PAPER NUMBER

2139

MAIL DATE

DELIVERY MODE

05/12/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/625,955

Applicant(s)

LEWIS ET AL.

Examiner

Matthew Heneghan

Art Unit

2139

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2008.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 and 20-53 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☒ Claim(s) 9-17 and 38-46 is/are allowed.
6) ☒ Claim(s) 1-8, 20-25, 27-37 and 47-53 is/are rejected.
7) ☒ Claim(s) 26 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 24 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

1. In view of the Appeal Brief filed on 21 February 2008, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

2. Claims 1-17 and 20-53 have been examined.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 27-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 27 recites the limitation "the encrypted data" in line 5. There is insufficient antecedent basis for this limitation in the claim. It is being presumed that this refers to received data that had been encrypted under the first key.

Claims 28-30 depend from rejected claim 27, and include all the limitations of that claim, thereby rendering those dependent claims indefinite.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-8, 20-25, 31-37, and 47-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 7,146,496 to Circenis et al. in view of U.S. Patent No. 6,389,543 to Dawson et al.

NOTE: Dawson was cited in the office action mailed 4 April 2007.

As per claims 1 and 6, Circenis discloses a system in which an ICOD (Instant Capacity On Demand, see column 1, line 18) capacity manager system receives commands from a software agent for controlling hardware such as CPUs (processors, see column 7, lines 15-24), Such as a command for components to be deactivated immediately (see column 7, lines 7-9), so as to make the resource unavailable to users of the apparatus.

Circenis does not disclose the manner in which the command for deactivation is processed when received.

Dawson discloses a system in which commands received by a system are validated before being executed at the destination node (see column 9, lines 19-30). Dawson further notes that this is done in order to determine whether the initiating administrator node has authority to execute the requested command (see column 2, lines 34-36).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention was made to modify the invention of Circenis by validating commands before being executed, as per Dawson, in order to determine whether the initiating administrator node has authority to execute the requested command

Regarding claim 2, Dawson further discloses that the validation process may include the authentication of security credentials of the caller (see column 9, lines 1-17) and the security credentials may comprise encrypted data that must be decrypted for validation (see column 4, lines 57-61).

As per claims 4, 20, 22-24, 47, 48, 50, and 51, the resource being deactivated is one that was previously enabled (unlocked, see column 7, line 60 to column 8, lines 4) by the user (see column 6, line 60 to column 7, line 14), such as due to an enforcement action.

As per claims 3, 25, 31, 36, and 49, Cirenis discloses the use of generated codewords from a portal (a code generator) to be validated that are specific to the ICOD system's serial number (see column 7, lines 62-67).

As per claim 5, the resource may be enabled to be requestable for users and disabled resources are unavailable to users, as stated above.

As per claim 7, Cirenis discloses that the resources may be drives or memory (see column 6, lines 15-16).

Regarding claim 8, Cirenis discloses that the system may issue warnings (such as for fraud) for which a user might take corrective action (see column 8, lines 51-56). It would be obvious for the user to send a disabling command in such a situation.

Regarding claim 21, the codes would both be encrypted/decrypted using the same public key algorithm (see Dawson, column 4, lines 57-61).

As per claim 32, Cirenis discloses that users may pay for the resources (see column 7, line 65).

Regarding claim 33, though Cirenis discloses the codeword generator being available through a portal, it would be obvious to incorporate this functionality directly into the system, so that it would be less dependent upon outside resources.

Regarding claims 34, 35, 37, and 53, Circenis and Dawson do not disclose the use of a secure smart chip having a unique key stored thereupon.

Official notice is given that it is well-known in the art to store private keys in public key/private key systems on secure smart chips, so that they may not be accessible outside the chip, thus maximizing secrecy.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Circenis and Dawson by using a smart chip having the private key stored thereon, as is well-known in the art.

Regarding claim 52, the user-controlled enablement and disablement functionalities described above must implicitly have a corresponding user interface in order to be usable.

Allowable Subject Matter

5. Claims 9-17 and 38-46 are allowed.
6. Claims 26 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. Claims 27-30 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

8. The following is a statement of reasons for the indication of allowable subject matter: No art could be found in the context of an on-demand system that would perform the validation process' encrypting and matching decrypting steps in the manner recited in claims 9, 26, 27, 38, and 46.

Claims 10-17 are allowed based upon their dependence upon base claim 9.

Claims 28-30 would be allowable based upon their dependence upon base claim 27.

Claims 39-45 are allowed based upon their dependence upon base claim 38.

Response to Arguments

9. Applicant's arguments, see Appeal Brief, filed 21 February 2008, with respect to the rejections of claims 9-17, 26, and 38-45 have been fully considered and are persuasive. The rejections under 35 U.S.C. 103 of claims 9-17, 26, and 38-45 have been withdrawn.

10. Applicant's arguments with respect to claims 1-8, 20-25, 27-37, and 46-53 have been considered but are moot in view of the new grounds of rejection.

Conclusion

11. Due to the new rejection under 35 U.S.C. 112, second paragraph, this office action is non-final.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew E. Heneghan, whose telephone number is (571) 272-3834. The examiner can normally be reached on Monday-Friday from 8:30 AM - 4:30 PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine Kincaid, can be reached at (571) 272-4063.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
P.O. Box 1450
Alexandria, VA 22313-1450

Or faxed to:

(571) 273-3800

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Art Unit: 2139

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Matthew Heneghan/

Primary Patent Examiner, USPTO AU 2139

May 16, 2008

/Kristine Kincaid/
Supervisory Patent Examiner, Art Unit 2139